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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/566,027	12/01/2006	Makoto Iwai	71,051-027	9309

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EXAMINER

BARTS, SAMUEL A

ART UNIT

PAPER NUMBER

1621

MAIL DATE

DELIVERY MODE

03/17/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/566,027

**Applicant(s)**

IWAI ET AL.

**Examiner**

Samuel A. Barts

**Art Unit**

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/86)  
Paper No(s)/Mail Date 12/1/2006
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Arnold (US 4,113,751).
3. The instant claims are drawn to a stabilizing agent for a hydroalkoxysilane comprising a carboxylate. One such claimed carboxylate is sodium acetate. Applicant is advised that the recitation of an intended use (i.e. “for a hydroalkoxysilane”) in the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, it meets the claim. Arnold discloses sodium acetate<sup>1</sup> thus meeting all the limitations of the claims.
4. Claims 1-17 are rejected under 35 U.S.C. 102(b) as being anticipated by WESTMEYER et al (US 6,365,696).
5. Claims 1-4 are described in the previous rejection. The prior art anticipates these claims because it discloses carboxylates such as sodium acetate, sodium propionate potassium acetate, and calcium acetate<sup>2</sup>.

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<sup>1</sup> See for example the abstract.

<sup>2</sup> See table 2 in columns 7-8.

6. Claims 5-13 are drawn to a method for stabilizing a hydroalkoxysilane by allowing the hydroalkoxysilane to coexist with a carboxylate. Table 2 in columns 7-8 discloses hydroalkoxysilane  $(\text{MeO}_3)\text{SiH}$  that coexist with multiple carboxylates. The prior art fails to clearly state that the hydroalkoxysilane is stabilized by the carboxylates. Applicants' attention is directed to *Ex parte Novitski*, 26 USPQ2d 1389 (BOPA 1993) illustrating anticipation resulting from the inherent use, absent a haec verba recitation for such utility. It is well settled law that administering compounds inherently possessing a protective utility anticipates claims directed to such protective use. Arguments that such protective use is not set forth haec verba are not probative, absent limitations distancing the proffered claims from the inherent anticipated use. In the instant case the hydroxysilanes inherently are stabilized with the carboxylates because they coexist together.

Claims 14-17 are drawn to a composition comprising a hydroalkoxysilane and a carboxylate. This composition clearly was taught by WESTMEYER<sup>3</sup>. The composition inherently is considered a stabilized composition. It is well settled that a prior art reference may anticipate when the claim limitations not expressly found in that reference are nonetheless inherent in it. "Under the principle of inherency, if the prior art necessarily functions in accordance with, or includes, the claimed limitations it anticipates." *MEHL/Biophile Int'l Corp. V. Miltraum*, 192 F.3d 1362, 1365, 52 USPQ2d 1303, 1305. In this case the word stabilized is assumed to exist in the prior art absent a statement to the contrary.

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<sup>3</sup> See table 2 in columns 7-8.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel A. Barts whose telephone number is 571-272-2870. The examiner can normally be reached on 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on 571-272-0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Samuel A Barts/  
Primary Examiner  
Art Unit 1621

SB

